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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91124762
Party	Defendant Interfashion Ltd.. B.V.I. and DC DESIGNS & CONCEPTS GMBH
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Date	03/18/2011
Attachments	Kapalua - Applicant's Brief in Opposition.pdf ( 7 pages )(575770 bytes )

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KAPALUA LAND COMPANY, LTD.,	)	
	)	
Opposer,	)	Opposition No.: 91124762
	)	Serial No. 76/023,641
v.	)	
	)	Cancellation No.: 92/040092
INTERFASHION LTD. B.V.I.,	)	Registration No. 2,115,124
and DC DESIGN & CONCEPTS GMBH,	)	
Applicants.	)	
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**APPLICANT'S/RESPONDENT'S BRIEF IN OPPOSITION  
TO OPPOSER'S MOTION TO AMEND CANCELLATION AND OPPOSITION**

**INTRODUCTION**

Applicant/Respondent DC DESIGN & CONCEPTS GmbH ("DC") hereby opposes opposer's motion to amend the cancellation and opposition, and requests that the motion be denied for the following reasons:

1. The motion to amend is untimely. Opposer delayed for over four (4) years, until March 3, 2011, before filing the motion after the Board suggested, in the Board's Order dated October 20, 2006, that opposer should consider filing such a motion.
2. If this motion is granted, DC would be extremely prejudiced as a direct result of opposer's delay in bringing the motion. Attached is the Declaration of Patrick Kaemmerer which details the extreme prejudice that would result to applicant if this motion is granted.

**ARGUMENT**

1. **Untimely**

The motion to amend is untimely. Opposer waited over four (4) years to file the motion. The Board's Order suggesting that applicant consider this amendment was issued October 20, 2006. That applicant retained new counsel in December 2010 does not excuse the four year delay prior to December 2010.

The fact that the parties were engaged in settlement negotiations does not excuse delaying for four years the filing of a simple motion.

Opposer's argument that it was attempting to minimize expenditures is weak. Clarifying the fraud claims by amending the pleading does not involve a significant expenditure of time or money. The proposed amended petition attached to opposer's motion consists of nineteen short paragraphs on four pages. The amendment involves the addition of one paragraph (#6) which is one sentence.

## 2. **Extreme Prejudice**

Most importantly, DC would be extremely prejudiced if this motion were granted, as set forth in the attached Declaration of Patrick Kaemmerer. The bottom line is that the long delay has left a cold evidence trail, i.e., the persons with information and the documents necessary to defend against the proposed amended claim are no longer available.

The current owner of the registration and application in issue, Reg. No. 2,115,124 and Serial No. 76/023,641, purchased the KAPALUA mark and the '124 Reg and '641 application about five years ago. The assignments for the '124 Reg and '164 application were recorded in the USPTO on December 28, 2006. The mark, registration and application were purchased from a bankruptcy proceeding in Germany (Kaemmerer Decl. ¶4). DC did not obtain the prior companies' business records in the purchase transaction, and does not know if such records exist or, if they do, where they may be (Kaemmerer Decl. ¶4). Because of the time that has passed since 2006, DC has no idea how to locate the documents or information necessary to defend against the proposed claim (Kaemmerer Decl. ¶7).

The Board's October 26, 2006 Order refers to affidavits signed by Mr. Reusch and Ms. Tan. Mr. Reusch and Ms. Tan are no longer associated with DC, and have not been for a few years (Kaemmerer Decl. ¶3). Both are believed to be working in Hong Kong, and no one at DC keeps in touch with them or knows how to reach them (Kaemmerer Decl. ¶3).

Some employees of DC had worked for the companies that previously owned the registration and application, but DC replaced them all near the end of 2008 (Kaemmerer

Decl. ¶5). Today, DC does not have any employees that previously worked for companies that owned the registration and application prior to DC (Kaemmerer Decl. ¶5).

The facts are clear that as of the end of 2008, DC has not been in a position to gather the information and documents it would need to defend against the proposed amendments. This is a direct result of opposer's delay in bringing this motion.

Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. Media Online Inc. v. El Clasificado, Inc., 2008 WL 4419361, 2 (TTAB 2008).

The question of prejudice is largely dependent upon the timing of the motion to amend. *See Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 22 USPQ2d 1526, 1531 (Fed. Cir. 1992); Wright, Miller and Kane, Federal Practice and Procedure: Civil 2d, Section 1488 (1990) ("Any party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion."). Oxyfresh Worldwide, Inc. v. Proactive Labs, Inc., 2004 WL 759506, \*1 (TTAB 2004).

It is important to note that the discovery of "abandonment due to non-use by a prior owner" and "subsequent invalid assignments" is not newly discovered evidence. This is evidence that was available to opposer in 2006.

The Board also stated that "[a] motion for leave to amend should be filed as soon as any ground for such amendment, e.g., newly discovered evidence, becomes apparent. A long delay in filing a motion for leave to amend may render the amendment untimely." *See International Finance Company v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002). The delay in this case, over four years, is not excusable.

The Board should deny this motion where, as here, DC would be prejudiced because its witnesses and evidence have become unavailable as a result of opposer's delay in filing this motion. Trek Bicycle Corporation v. StyleTrek Limited, 64 USPQ2d 1540 (TTAB 2001).

**CONCLUSION**

For the foregoing reasons, opposer's motion should be denied.

Dated: March 18, 2011.

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Applicants.	)	

**DECLARATION OF PATRICK KAEMMERER  
IN OPPOSITION TO OPPOSER'S MOTION TO  
AMEND CANCELLATION AND OPPOSITION**

I, Patrick Kaemmerer, declare under penalty of perjury under the laws of the United States of America that the following is true and correct.

1. I have knowledge of the matters set forth herein.
2. I am the Head of Sales for the KAPALUA brand of applicant/respondent DC DESIGN & CONCEPT GmbH ("DC"). I have been with DC since September 2007.
3. Mr. Reusch and Ms. Tan who were previously involved with companies that previously owned the KAPALUA brand, and they both submitted declarations in this case in connection with the abandonment issues. Ms. Reusch and Ms. Tan are no longer associated with DC, and have not been involved with the KAPALUA brand for a few years. The last that I heard about Mr. Reusch and Ms. Tan is that they were both working in Hong Kong. No one at DC keeps in touch with them nor knows how to reach them.
4. The companies that previously owned the KAPALUA brand were involved in bankruptcy proceedings in Germany. DC purchased the KAPALUA brand through these bankruptcy proceedings. DC did not obtain the prior owners' business records when purchasing

the KAPALUA brand, and I do not have any knowledge whether or not any such records still exist or where such records may be located if they do exist.

5. DC is a separate company from the companies that previously owned the KAPALUA brand. Prior to the end of 2008, DC did have managers, designers and/or employees that previously worked for the companies that previously owned the KAPALUA brand. At the end of 2008, DC replaced everyone that ever worked at any company that owned the KAPALUA brand. DC does not have any employees that previously worked for companies owning the KAPALUA brand.

6. When DC purchased the KAPALUA brand from the bankruptcy proceedings, DC was aware that there was a legal proceeding pending in the U.S. regarding the name KAPALUA, but DC did not have any firsthand knowledge regarding the facts or records of the case.

7. Because of the time that has passed, I have no idea how to locate documents or to contact people that previously worked for DC or companies that previously owned the KAPALUA brand. I do not believe that I could obtain information or documents regarding use of the KAPALUA brand prior to DC's purchase of the brand.

Dated: March 18, 2011.

/s/ Patrick Kaemmerer

Patrick Kaemmerer

Head of Sales

DC Design & Concepts GmbH

**CERTIFICATE OF SERVICE**

I hereby certify that on March 18, 2011, a true copy of the foregoing Applicant'/Respondent's Brief in Opposition to Opposer's Motion to Amend Cancellation and Opposition was served on the following attorneys for Kapalua Land Company, Ltd. via email and the United States Postal service, first class mail, postage prepaid:

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By: /s/ Joseph F. Schmidt

Attorneys for  
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